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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,330	02/06/2004	Gregory R. Furnish	59472.22104	8531

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EXAMINER
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MAI, HAO D

ART UNIT	PAPER NUMBER
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3732

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07/02/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/774,330	<b>Applicant(s)</b> FURNISH ET AL.	
	<b>Examiner</b> HAO D. MAI	<b>Art Unit</b> 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 27, 28, 30, 32-36 and 47-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27, 28, 30, 32-36, 47-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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## DETAILED ACTION

### *Claim Objections*

1. Claim 49 is objected to because of the following informalities: claim 49 is incomplete.

Appropriate correction is required.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. **Claims 27, 28, 30, 32-36, and 47-49, are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,254,535. This is a non-statutory double patenting rejection.**

The conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). The conflicting claims are claiming essentially the same invention.

### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**5. Claims 27-28, 30, 32-33 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Barish et al. (3240516) in view of Heifetz (4606522).**

**Regarding claim 27,** Barish et al. disclose a joint structure of a retractor comprising:

- a. a bifurcated member 22 having two elongated prongs 24, each prong having a proximal end and an opposite distal end, said prongs attached to each other adjacent the proximal ends thereof, at least a portion of each prong is capable of engaging a heart of a patient and wherein the prongs of said bifurcated member are attached to each other by means of a connecting member (horizontal bar between 20 and 22), said connecting member having opposed ends in which each end is fixedly attached to one prong adjacent its proximal (Fig. 1);
- b. an elongated handle segment consisted of structures 10 and 68 having a first end 14 and an opposite second end 32 (Figs. 1-2);
- c. a longitudinally-extending bore (hollow) within said handle segment (Fig. 2; column 1 line 68);
- d. a ball 72 disposed within said bore adjacent the first end 14 of said handle segment, a portion of said ball fixedly attached to said bifurcated member via member 20, wherein the bore and the ball form a connection that allows said bifurcate member to rotate and pivot relative to said handle segment so that said bifurcated member is movable to a desired position (Figs. 1-2; column 2 lines 34-37);
- e. a shaft 40 having an upper end and an opposite lower end such that at least a portion of said shaft is complementarily received within said bore (Fig. 2);
- f. a socket 74 attached to the lower end of the shaft 40, said socket having an interior surface of a size to complementarily and detachably engage said ball;

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Barish et al. disclose the invention substantially as claimed. Barish et al. also disclose the wedged joint 18 with handle 64 (Fig. 3) for controlling the relative movement between the shaft 40 and the hollow bore of the handle 10, as the shaft is moved within said bore. However, Barish et al. fails to disclose a portion of said bore complementarily engages a portion of said shaft so that the interface there between controls the relative movement between said shaft and said bore as said shaft is moved within said bore (claim 1).

Heifetz discloses a medical instrument holder comprising a handle 20 having a bore 22 (hollow) and a shaft 55 complementarily received therein (Fig. 1). A portion of the bore is shown to complementarily engage a portion of the shaft via threads 63 and 62. The threaded interface 62/63 controls the relative movement between the shaft and the bore as the shaft is moved within said bore; wherein the rotation of the corresponding tightener 61 controls the movement of the threaded interface 62/63 (Fig. 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Barish et al. by substituting the wedged joint with tightening handle for the threaded interface and rotatable tightener mechanism taught by Heifetz as a suitable alternative mechanism for controlling the movement of the shaft within the bore. Such modification is merely a design choice well within the skill of an artisan and would yield the same and/or predictable results, i.e. controlling the movement of the shaft within the bore.

**As to claim 28**, Barish et al. disclose ball 72 to be movable secured within said bore so that the ball and attached bifurcated member 22 (via rod 20) are rotatably and pivotally movable relative to said handle segment without separating therefrom (Fig. 2; column 2 lines 34-37).

**As to claims 30**, the attached socket 74 is shown to be within said bore of handle 10/68 between an engaged position (when frictionally attached to ball 72), in which the interior surface of said socket detachably engage said ball to frictionally hold said ball in the desired position,

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and a disengaged position (when detached from ball 72), in which the interior surface of said socket and said ball are spaced apart so that said ball is movable (Figs. 1-2; column 2 lines 34-52)

**As to claims 32-33**, note the modification of Barish in view of Heifetz detailed above with respect to the threaded interface between the shaft and the bore and the tightener for controlling the threaded interface.

**Regarding claim 48**, Barish/Heifetz disclose all the claimed elements as detailed above with respect to claim 27.

**6. Claims 34-36, 47, and 49, are rejected under 35 U.S.C. 103(a) as being unpatentable over Barish et al. (3240516) in view of Heifetz (4606522), and further in view of Biegler (2674501).**

Barish/Heifetz disclose the invention substantially according to claims 27 and 48. However, Barish/Heifetz fail to disclose means for removably mounting the bifurcated member 24 to the handle 10, such means comprising of an opening in the handle segment for allow the ball to traverse therethrough (claims 34-36, 47, 49).

Biegler discloses a handle connection for a garden hoes that has a ball structure as Barish et al.'s bifurcated member. Biegler teaches of a means for removably mounting the ball 18 to handle 14 at the expansible socket 22. The expansible socket is a portion of the handle and defines opening(s) therethrough for allowing the ball to traverse therethrough between occupied and withdrawn positions (Fig. 1; column 1 lines 48-62). It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute Barish/Heifetz's ball retainer 70 (taught by Barish) with Biegler's expansible socket 22 so that the connecting ball may be removably mounted as explicitly taught by Biegler.

***Response to Arguments***

7. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HAO D. MAI whose telephone number is (571)270-3002. The examiner can normally be reached on Monday-Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on (571) 272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hao D Mai/  
Examiner, Art Unit 3732

/Cris L. Rodriguez/  
Supervisory Patent Examiner, Art Unit 3732